

## **REMARKS**

Applicant respectfully requests reconsideration and allowance of the subject application. Claims 1-29 are pending, of which claims 14 and 24 have been amended. The amendment to claim 14 is purely of form to correct an 5 informality noted by the Applicant.

### **Provisional Double Patenting Rejection**

Claims 1-29 are rejected as being directed to an invention not patentably distinct from claims of a commonly assigned application 09/793,466 (Pub. No. 10 US 2002/0119029 A1 to Cobene et al. (hereinafter, "Cobene") (*Office Action* p.2). The Hewlett-Packard Company is the assignee of both the present application and Cobene which was filed February 26, 2001 and published August 29, 2002.

Applicant respectfully disagrees that claims 1-29 of the present 15 application are obvious over the claims of Cobene. For example:

Claim 1 recites a method comprising "aligning a first page of a publication with a second page, the first and second pages having a pre-applied adhesive" and "pressing the first page against the second page to activate the 20 adhesive on the first and second pages, wherein a cohesive bond is formed between the adhesive on the first page and the adhesive on the second page."

Cobene does not claim or describe "pages having a pre-applied adhesive", as recited in claim 1. Further, the Office has not provided any indication as to which feature(s) in Cobene are being relied upon to substantiate 25 the rejection.

The Office only relies on one example of a similarity between claims as a basis for the double patenting rejection. The Office states that "aligning a

cover with the first page, the cover having a pre-applied adhesive” in pending claims 9-13 and 16-19 is an obvious variation of “registering a single-piece cover with the ends of a text body” in copending claims 1 and 12 of Cobene (*Office Action* p.2, ¶1; p.3, ¶2; p.4, ¶3). The Office does not provide any comparable reference to the other pending claims 1-8, 14-15, and 20-29.

Claim 1 is patentably distinct over Cobene because Cobene makes no mention whatsoever of “pages having a pre-applied adhesive”, as recited in claim 1. Accordingly, claim 1 is allowable over Cobene and Applicant respectfully requests that the rejection be withdrawn.

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Claims 2-14 are allowable by virtue of their dependency upon claim 1 (either directly or indirectly) and are patentably distinct over Cobene when considered in combination with claim 1. Additionally, some or all of claims 2-14 are allowable over Cobene for independent reasons. For example:

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Claims 5 and 6 recite “applying the adhesive” on or to “the first and second pages before aligning”. Cobene makes no mention of applying an adhesive to pages before aligning the pages, as recited in claims 5 and 6.

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Claim 15 recites “applying an adhesive to a publication page before the page is printed”. As described above in the response to the rejection of claim 1, Cobene makes no mention whatsoever of applying an adhesive to a publication page before the page is printed, as recited in claim 15. Accordingly, claim 15 and dependent claim 16 are patentably distinct and allowable over Cobene and Applicant respectfully requests that the rejection be withdrawn.

Claim 17 recites “A publication page, comprising a pressure set adhesive applied to the page before the page is printed and before the page is aligned to be bound with a publication.” As described above in the response to the rejection of claim 1, Cobene makes no mention whatsoever of an adhesive applied to a page before the page is printed or aligned to be bound with a publication, as recited in claim 17. Accordingly, claim 17 and dependent claims 18-20 are patentably distinct and allowable over Cobene and Applicant respectfully requests that the rejection be withdrawn.

10       Claim 21 recites “A publication cover, comprising a pressure set adhesive applied to the cover before the cover is printed and before the cover is aligned to be bound with a publication.” Cobene makes no mention whatsoever of an adhesive applied to a cover before the cover is printed, as recited in claim 21. Accordingly, claim 21 and dependent claims 22-23 are 15 patentably distinct and allowable over Cobene and Applicant respectfully requests that the rejection be withdrawn.

20       Claim 24 recites “an alignment system configured to align a first page of a publication with a second page, the first and second pages having a pre-applied adhesive”. As described above in the response to the rejection of claim 1, Cobene makes no mention whatsoever of pages having a pre-applied adhesive, as recited in claim 24. Accordingly, claim 24 and dependent claims 25-29 are patentably distinct and allowable over Cobene and Applicant respectfully requests that the rejection be withdrawn.

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**35 U.S.C. §103 Provisional Claim Rejections**

Claims 1-29 are provisionally rejected under 35 U.S.C. §103(a) for obviousness over copending Cobene which would constitute prior art under 35 U.S.C. §102(e) if published or patented (*Office Action* p.4). Applicant  
5 respectfully traverses the rejection.

For the reasons described above in response to the double patenting rejection, pending claims 1-29 are allowable over Cobene. Further, Cobene would not constitute prior art under §102(e) because Cobene does not show or disclose any form of pages having a pre-applied adhesive, applying an adhesive  
10 to a publication page before the page is printed, or an adhesive applied to a cover before the cover is printed, as recited in claims 1, 15, 17, 21, and/or 24.

Accordingly, claims 1-29 are allowable over Cobene and Applicant respectfully requests that the provisional §103 rejection be withdrawn.

15 **Conclusion**

Pending claims 1-29 are in condition for allowance. Applicant respectfully requests reconsideration and issuance of the subject application. If any issues remain that preclude issuance of this application, the Examiner is urged to contact the undersigned attorney before issuing a subsequent Action.

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Respectfully Submitted,

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